

Remarks/Arguments

Claims 1-22 are currently pending in this application. Claim 12 has been withdrawn new Claim 22 is drawn to X being S.

Restriction has been required under 35 U.S.C. 121 and 372. Applicant traverses this restriction.

The Office Action stated that Claims 1 to 21 are drawn to more than one inventive concept (as defined by PCT Rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2.

The Office Action stated that PCT Rule 13.2 states that the International application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

The Office Action stated that PCT Rule 13.2 states unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

The Office Action stated that Annex B, Part 1 (b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.

The Office Action stated that Annex B, Part 1 (e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of anyone of the following combinations of claims of different categories in the same international application:

- (i) in addition to an independent claim for a given product, an independent claims for a process specially adapted for the manufacture of the said product, and an independent claim for use of the said product, or
- (ii) in addition to an independent claim for a given process, an independent

claim for an apparatus or means specially designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, and independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specially designed for carrying out the said process, ... "

The Office Action stated that this application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The Office Action stated that due to the different classes found among the compounds of the formula (I), e.g. furyl vs. thienyl, a precise listing of inventive groups cannot be made. Applicants traverse this statement.

The Office Action stated that the following groups are exemplary:

Group 1, Claims 1 to 11 and 13 to 21 (in-part), are drawn to a process for the preparation of compounds of formula (I) wherein: X is S; and R represents hydrogen or C₁₋₆ alkyl, C₃₋₈ cycloalkyl, aryl or aralkyl, classified in class 514.

Group II, Claims 1 to 11 and 13 to 21 (in-part), are drawn to a process for the preparation of compounds of formula (I) wherein: X is O; and R represents hydrogen or C₁₋₆ alkyl, C₃₋₈ cycloalkyl, aryl or aralkyl, classified in class 514.

Group III, Claims 12 (in-part), is drawn to compounds of formula (I) wherein: X is S; and R represents hydrogen or C₁₋₆ alkyl, C₃₋₈ cycloalkyl, aryl or aralkyl, classified in class 514 and 549.

Group IV, Claims 12 (in-part), is drawn to compounds of formula (I) wherein: X is O; and R represents hydrogen or C₁₋₆ alkyl, C₃₋₈ cycloalkyl, aryl or aralkyl, classified in class 514 and 549.

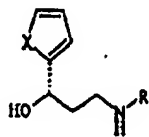
The Office Action stated that, in accordance with 37 CFR 1.499, applicants are required, in reply to this Action, to elect a single invention to which the claims must be restricted.

Applicants elect with traverse the invention of Group I, Claims 1 to 11 and 13 to 21 (in part) plus new Claims 22.

New Claim 22 comes within the elected inventions, i.e., Group I.

The Office Action stated therefore, applicants may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The Office Action stated that if applicants are unable to elect a single invention, applicants may instead choose to elect a specific compound and examiner will attempt to group it. The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art (see, Liu, et al., compound 6, for example). Applicants traverse this statement as being a mere assertion that is not supported by facts and factual analysis in the record. The non-elected compound, as a whole, have a significant structural element that is a contribution over the prior art.

The Office Action stated that the compounds contains , which does not define a contribution over the prior art. The compounds vary in classification and when taken as a whole result in vastly different compounds.

The Office Action stated that, accordingly, the vastness of the claimed subject matter and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter. This is not a basis under the patent statute that allows a restriction requirement.

The Office Action stated that the following is a recitation of M.P.E.P. 821.04, Rejoinder:

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. However, if applicant elects claims directed to the product, and a product claim is Subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Where the application as originally filed. discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the process of making and/or using the patentable product by way of amendment pursuant to 37 CFR 1.121. In view of the rejoinder procedure, and in order to expedite prosecution, applicants are encouraged to present such process claims, preferably as dependent claims, in the application at an early stage of prosecution. Process claims which depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance. Amendments submitted after final rejection are governed by 37 CFR 1.116. Process claims which do not depend from or otherwise include the limitations of the patentable product will be withdrawn from consideration, via an election by original presentation (see MPEP § 821.03). Amendments submitted after allowance are governed by 37 CFR 1.312. Process claims which depend from or otherwise include all the limitations of an allowed product claim and which meet the requirements of 35 U.S.C. 101, 102, 103, and 112 may be entered.

Where product and process claims are presented in a single application and that application qualifies under the transitional restriction practice pursuant to 37 CFR

1.129(b), applicant may either: (A) elect the invention to be searched and examined and pay the fee set forth in 37 CFR 1.17(s) and have the additional inventions searched and examined under 37 CFR 1.129(b)(2); or (8) elect the invention to be searched and examined and not pay the additional fee , (37 CFR 1.129(b)(3)). Where no additional fee is paid, if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined. If applicant chooses to pay the fees to have the additional inventions searched and examined pursuant to 37 CFR 1.129.(b)(2) even if the product is found allowable, applicant would not be entitled to a refund of the fees paid under 37 CFR 1.129(b) by arguing that the process claims could have been rejoined. 37 CFR 1.26(a) states that "[T]he Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee ... will not entitle a party to a refund of such fee ... " In this case, the fees paid under 37 CFR 1.129(b) were not paid by mistake nor paid in excess, therefore, applicant would not be entitled to a refund. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101,102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may' be made final, or, if the application was already under final rejection, the next Office action may be an advisory action. Form paragraphs 8.42 through 8.44 should be used to notify applicant of the rejoinder of process claims which depend from or otherwise include all the limitations of an allowable product claim.

In the event of rejoinder, the rejoined process claims will be fully examined for patentability.in accordance with 37 CFR 1.104 • 1.106. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35

U.S.C. 101, 102, 103, and 112. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

The Office Action stated that the following is a recitation from paragraph five, "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)" [1184 TMOG 86(March 26, 1996)]:

"However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined."
(Emphasis Added)

The Office Action stated: that, therefore, in accordance with M.P.EP 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable; that until, such time, a restriction between product claims and process claims is deemed proper; that additionally, in order to retain the right to rejoinder in accordance with the above policy, applicants are advised that the process claims should be amended during prosecution to maintain either dependency on the product claims or to otherwise include the limitations of the product claims; and that failure to do so may result in a loss of the right to rejoinder.

The Office Action stated that applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicants elect with traverse the invention of Group I, Claims 1 to 11 (in part), 12 to 21 (in part), and 22.

Applicants reserve the right to file divisional and/or continuation application to the non-elected inventions.

Reconsideration and allowance of the claims and withdrawal of the restriction requirement are requested.

Respectfully submitted,

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Date

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